

MAY 02 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/644,981 Confirmation No. : 6366  
First Named Inventor : Bernd SUNDERMANN  
Filed : August 21, 2003  
TC/A.U. : 1625  
Examiner : C. Aulakh  
  
Docket No. : 029310.52539US  
Customer No. : 23911  
  
Title : Substituted Propane-1,3-Diamine Derivatives and  
The Pharmaceutical Use Thereof

REPLY TO OFFICE ACTION

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the requirement for restriction in the Office Action mailed March 31, 2005 in the above-identified patent application, applicants hereby provisionally elect the claims of Group IV, namely claims 1-36, for further prosecution in this application. This provisional election is made with traverse.

The requirement for restriction is respectfully traversed because restriction within a single claim is not proper. As stated by the court in *In re Weber*, 580 F.2d 455; 198 USPQ 328, 331 (CCPA 1978):

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it. (citation omitted) As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be

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that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

Thus, the present claims, which define what the applicants regard as their invention in accordance with the provisions of the patent statute, should be examined under the provisions of M.P.E.P. §803.02. Note that the claimed compounds satisfy the requirements of In re Harnish, 631 F.2d 716, 206 U.S.P.Q. 300 (CCPA 1980) for a proper Markush claim since they (1) share the common utility of analgesic activity, and (2) share the substantial structural feature of the diaminopropane backbone of formula I, which is disclosed as being essential to that utility. Reconsideration and withdrawal of the improper restriction requirement are therefore respectfully requested.

Responsive to the requirement for election of species, applicants hereby elect the species of Example 3, namely (syn,syn)-2-chloro-N-[2-(dimethylamino-pyridin-3-ylmethyl)-cyclohexyl]-benzamide. Claims 1-4, 11-15, 20-24, 26-28 and 32-36 are believed to read on the elected species. This election is made without traverse since the species are believed to be patentably distinct.

Favorable action on the application is earnestly solicited.

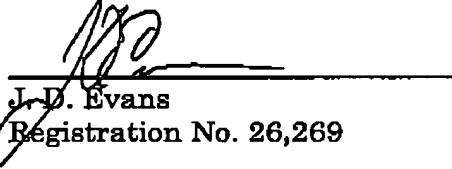
If there are any questions regarding this Reply or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

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This Reply is believed timely since April 30, 2005 fell on a Saturday, and May 2, 2005 is the first following business day on which the Office is open to receive mail. However, if necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 029310.52589US).

Respectfully submitted,

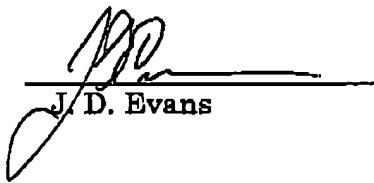
May 2, 2005

  
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CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that this Reply to Office Action is being transmitted to the U.S. Patent and Trademark Office by facsimile transmission to (703) 872-9306 this 2<sup>nd</sup> day of May 2005.

  
J. D. Evans